ILE COPY

Office-Supreme Court, U.S.
FILED
MAR 4 1965
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1964.

No. [redacted] 11

WILLIAM T. GRAHAM, AND GRAHAM PLOW, INC.,
Petitioners,

vs.

JOHN DEERE COMPANY OF KANSAS CITY, AND DEERE & COMPANY,
Respondents.

BRIEF, AMICUS CURIAE.

ILLINOIS STATE BAR ASSOCIATION,
GEORGE E. FROST,
135 So. LaSalle Street,
Chicago, Illinois,
JAMES M. WETZEL,
38 South Dearborn Street,
Chicago, Illinois.

Chicago, Illinois,

March 4, 1965.

THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

INDEX.

	PAGE
Authority to File	1
Interest of the Illinois State Bar Association	1
Argument	3
I. Development of the Law of Unobviousness	3
II. 35 U. S. C. 103 and Its Purpose	4
III. Constitutional and Statutory Provisions Involved	5
IV. The Eighth Circuit Opinion Below	6
V. The Fifth Circuit Opinions on Section 103	7
VI. Section 103 Is Constitutional	7
VII. Section 103 Is in Furtherance of the Public Interest and Must Be Given Its Full Effect	9
Appendix A	11
Appendix B	13

CITATIONS.

Cases:

Bank v. Sherman, 101 U. S. 403, 406 5
Hotchkiss v. Greenwood, 52 U. S. (11 Howard) 248 (1850) 3, 5, 9
Sinclair Refining Co. v. Atkinson, 370 U. S. 195, 203 5

Statutes:

1 Statute 102 8
1 Statute 318 8
35 U. S. C. 101 8
35 U. S. C. 102 8
35 U. S. C. 103 ..... 2, 3, 4, 5, 6, 7, 8, 9, 10

Miscellaneous:

Constitution, Article I, Section 8, Clause 8 ..... 5, 6, 7
House Report No. 1923, May 12, 1952, Page 8 4

IN THE

Supreme Court of the United States

OCTOBER TERM, 1964.

No. 580.

WILLIAM T. GRAHAM, AND GRAHAM PLOW, INC.,
Petitioners,

vs.

JOHN DEERE COMPANY OF KANSAS CITY, AND DEERE & COMPANY,
Respondents.

BRIEF, AMICUS CURIAE, FOR THE ILLINOIS STATE BAR ASSOCIATION.

AUTHORITY TO FILE.

This brief, Amicus Curiae, is presented to the Court under Rule 42-2. The letters of consent from the Petitioners and the Respondents are on file with the Clerk of the Court. Copies are attached hereto as Appendix A and Appendix B, respectively.

INTEREST OF THE ILLINOIS STATE BAR ASSOCIATION.

The Illinois State Bar Association is an association of members of the bar of the State of Illinois. We are concerned with the application of the law in the public interest. We believe that an expression of our views on Title 35, Section 103, United States Code, will aid this Court in determining the important issues raised by the present case.

We are specifically moved to file this brief because this is the first case before this Court on Title 35, Section 103 and, further, because we believe that the opinion of the Court of Appeals for the Eighth Circuit below errs in its departure from this statute. We have no concern with, and express no views on, the private interests of any party to this litigation.

ARGUMENT.

I. DEVELOPMENT OF THE LAW OF UNOBVIOUSNESS.

The first patent law was enacted in 1790. With the exception of Section 2 of the 1793 Patent Act, repealed in 1836, no patent act prior to 1952 set forth a quantitative standard of how the subject matter of a patent must differ from the prior art. A rule based on the "skill of the art" standard was, however, evolved by judicial decision.

The leading case is this Court's decision in *Hotchkiss* v. *Greenwood,* 52 U. S. (11 How.) 248 (1850). This Court there affirmed the judgment of the trial court. The trial court charged the jury that if

> "no more ingenuity or skill (was) required to construct the knob in this way than that possessed by an ordinary mechanic acquainted with the business, the patent was invalid." (Page 265.)

In a dissenting opinion, Mr. Justice Woodbury expressed the view that the instruction should have followed a less stringent test of "cheaper and better". (52 U. S. (11 How.) at p. 267.)

The "skill in the art" test enunciated in *Hotchkiss* v. *Greenwood* has been followed, in the main, by this Court and the lower Federal Courts. In the years immediately preceding 1952, some language used in opinions of this Court led some to believe that the "skill of the art" test had been displaced by an even more stringent standard. Section 103 was enacted in 1952 to resolve these uncertainties.

II. 35 USC 103 AND ITS PURPOSE.

Section 103, Title 35, United States Code, reads as follows:

> "Conditions for patentability; non-obvious subject matter
>
> *A patent may not be obtained* though the invention is not identically disclosed or described as set forth in Section 102 of this title, *if the differences between the subject matter sought to be patented and the prior art are such that the subject matter* as a whole *would have been obvious* at the time the invention was made *to a person having ordinary skill in the art* to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made." (Emphasis added.)

This section of the statute codified the law. It was intended to lend a "stabilizing effect" on the determination of patentability. See House Report No. 1923, May 12, 1952, page 8. The committee report further states:

> "Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent . . . Section 103 states this requirement in the title.
>
> "That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness . . ." (Id.)

Thus, according to the standard as restated in Section 103, a patent can be awarded only for that which would not have been obvious to a person having ordinary skill in the

art at the time the invention was made. This language is similar to that endorsed by a majority of this Court in *Hotchkiss* v. *Greenwood.*

Section 103 equally rejects a standard such as "better and cheaper". It thus rejects the standard followed in Mr. Justice Woodbury's dissent in *Hotchkiss* v. *Greenwood.*

Section 103 is a statutory expression of the "skill of the art" test. It should be applied according to the plain import of its words. *Bank* v. *Sherman,* 101 U. S. 403, 406; *Sinclair Refining Co.* v. *Atkinson,* 370 U. S. 195, 203.

III. CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED.

Constitution.

Article I, § 8, Clause 8.

The Congress shall have the power * * * to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; * * *

Statutes.

Title 35 U. S. C.

§ 103. Conditions for patentability; nonobvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

IV. THE EIGHTH CIRCUIT OPINION BELOW.

The court below in the present case noted that the "trial court couched its Finding XV rather precisely in the statutory standard of invention found in 35 U. S. C. § 103". R. 923, 333 F. (2d) 529, 534. The court continued, however, to state:

> "But, other findings of the court lay stress on 'an improved functional result,' and nowhere does the court find any new or significantly different result. * * *"

Moreover, the court stated:

> "In conclusion, we observe once again that the Constitution, Article I, Section 8, Clause 8, authorizes Congress to reward inventive genius but not mechanical skill alone. *Cuno Engineering Corporation* v. *Automatic Devices Corporation, supra,* 314 U. S. at 91; *Steffan* v. *Weber Heating and Sheet Metal Company, supra,* 237 F. 2d at 604 . . ." R. 924, 333 F. (2d) 529, 535.

We submit that here the court below has erred.

Congress has defined the required change over the prior art in Section 103. It is to that statute, and to that statute alone, that the court below should have addressed itself. The test of the statute is whether the subject matter as a whole would have been obvious to one skilled in the art —not whether there is a "new or significantly different result" or whether there is "inventive genius".

The trial court recognized this, addressed itself to the statute, and found as an ultimate fact that the statutory standard of invention of Section 103 had been met. If the trial court was clearly erroneous in this fact finding, the court below certainly should have reversed. But in the absence of determination that such fact finding was clearly erroneous, the court below was bound to affirm. In no event, we submit, should the Eighth Circuit Court of Appeals have

engrafted on Section 103 a fact requirement of "new or significantly different result", "inventive genius", or anything else that the statute nowhere contains.

V. THE FIFTH CIRCUIT OPINIONS ON SECTION 103.

We note that the court below reads decisions of the Court of Appeals for the Fifth Circuit as requiring only that a patented combination of old elements produce "an old result in a cheaper and otherwise more advantageous way". R. 922, 333 F. (2d) 529, 533. We make no comment on whether this is a correct or incorrect reading of that Court's decisions. However, we do point out that in reaching an ultimate fact finding on unobviousness a court can and should consider various basic facts that go to the determination of the ultimate fact expressed in the statute. Among these basic facts are whether the result achieved is old or new, whether the result is achieved in a cheaper or otherwise more advantageous way, and the like. But if the Court of Appeals for the Fifth Circuit really has substituted an ultimate standard of "cheaper and otherwise more advantageous way" for the ultimate fact of unobviousness as expressed in Section 103, we believe that it too has erred.

VI. SECTION 103 IS CONSTITUTIONAL.

Section 103 was enacted pursuant to Article I, Section 8, clause 8 of the Constitution. This gives the Congress power:

> ". . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

This provision assigns to Congress a broad responsibility to determine the subject matter, the conditions, and the term for which it will grant patents. Since 1790 the

Congress has exercised this power through the enactment of general patent statutes that specifically define patentable subject matter, the patent term, what is "prior art" and other conditions and terms of the patent grant.

For example, in Section 1 of the 1790 Patent Act Congress defined patentable subject matter as "any useful art, manufacture, engine, machine, or device, or any improvement therein." (1 Stat. 102.) Today, Section 101 of the 1952 Patent Code defines patentable subject matter to include "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof . . ."

Similarly Section 1 of the 1790 Patent Act, required that the "useful art, manufacture" etc. be "not before known or used." (1 Stat. 102.) Today, Section 102 of the 1952 Patent Code sets forth related requirements that the invention not be "known or used by others" or "patented or described in a printed publication" and the like.

Not only this, there is a specific statutory precedent for Section 103 of the 1952 Patent Code. This is found in the 1793 "Act to promote the progress of useful Arts." (1 Stat. 318.) The terminal sentence of Section 2 of that Act reads:

> "And it is hereby enacted and declared, that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery." (1 Stat. 318.)

The provisions of Section 103 of the 1952 Patent Code reflect the determination of the Congress of what may be patented, how it may be patented, and the term of the patent when granted. As to all of these many aspects of the law, the Congress has made a legislative determination that the Constitutional power permits, that public policy requires, and that the public interest is protected and promoted by, the patent law as expressed in the statute.

There is no valid reason to interfere with the legislative determination of Congress expressed in Section 103. Indeed, it expresses in statutory language substantially the same "skill in the art" test that this Court itself enunciated in *Hotchkiss* v. *Greenwood*, 52 U. S. (11 Howard) 248 (1850). It also follows the precedent of the 1793 Patent Act which in part defined a wholly comparable standard.

VII. SECTION 103 IS IN FURTHERANCE OF THE PUBLIC INTEREST AND MUST BE GIVEN ITS FULL EFFECT.

The standard of patentability set forth in Section 103 is stringent. No common change over the prior art can measure up as "unobvious." Patentability is reserved for the exceptional cases. This is as it should be. The public interest is safeguarded.

At the same time, the standard is not impossible to meet. Again, this is as it should be. Unless business enterprise and inventors are advised in advance that they face an attainable (though strict) standard, the patent law stimulus to invent and to market becomes theory and not reality.

Section 103 serves an additional important function. It defines a fact standard for the courts and the Patent Office to apply. Attainment of the Constitutional objective of progress of the useful acts is clearly aided by this carefully framed legislatively expressed standard.

Insofar as the court below relied upon standards other than that expressed in Section 103, we submit that the court erred.

Respectfully submitted,

ILLINOIS STATE BAR ASSOCIATION,
GEORGE E. FROST,
135 So. LaSalle Street,
Chicago, Illinois,
JAMES M. WETZEL,
38 South Dearborn Street,
Chicago, Illinois,
Its Attorneys.

Chicago, Illinois,

March 2, 1965.

APPENDIX A.

(Letterhead of Claude A. Fishburn and Orville O. Gold, Kansas City, Mo. 64106.)

Febbruary 16, 1965

Mr. George Frost
135 So. La Salle Street
Chicago, Illinois

In re: No. 580 in the Supreme Court of the United States; William T. Graham and Graham Plow, Inc., Petitioners, vs. John Deere Company of Kansas City and Deere & Company, Respondents.

Dear Mr. Frost:

In behalf of the petitioners in the above cause, we hereby consent to your filing an amicus curiae brief in behalf of the Section on Patent, Trademark and Copyright Law of the Illinois State Bar Association.

Yours very truly,

Fishburn and Gold,
By: Claude A. Fishburn.

CAF:fj

cc: Mr. Tom Arnold, Chairman
Patent, Trademark and Copyright Section
American Bar Association
2220 Tennessee Building
Houston, Texas 77002

cc: Mr. S. Tom Morris
630 Amarillo Building
Amarillo, Texas 79101

cc: Mr. James M. Wetzel
Hume, Groen, Clement & Hume
38 So. Dearborn Street
Chicago, Illinois 60603

APPENDIX B.

(Letterhead of Gibson, Ochsner, Harlan, Kinney & Morris, Amarillo, Texas 79101.)

February 18, 1965

Air Mail
Mr. George E. Frost, Chairman,
Section on Patents, Trademarks
and Copyright Law
Illinois State Bar Association
135 South LaSalle Street
Chicago, Illinois

In re: No. 580 in the Supreme Court of the United States; William T. Graham and Graham Plow, Inc., Petitioners, vs. John Deere Company of Kansas City and Deere & Company, Respondents

Dear Mr. Frost:

We acknowledge Mr. Wetzel's letter of February 16, 1965, and in behalf of the Respondents in the above cause I hereby consent to your filing an amicus curiae brief in behalf of the Section on Patents, Trademarks and Copyright Law of the Illinois State Bar Association.

Yours very truly,

Gibson, Ochsner, Harlan, Kinney & Morris,

By S. Tom Morris.

STM/fj

cc: Mr. James M. Wetzel
Hume, Groen, Clement & Hume
38 So. Dearborn Street
Chicago, Illinois 60603

Fishburn and Gold
Attorneys at Law
1217 Commerce Trust Building
Kansas City, Missouri 64106

Mr. Thomas E. Scofield
Scofield, Kokjer, Scofield & Lowe
1325 Rialto Building
Kansas City 6, Missouri